

Appl. No. : 09/809,545
Filed : March 14, 2001

REMARKS

Claims 20-31 are pending in the application. Claims 1-19 and 23 have been cancelled. Applicants reserve the right to pursue the subject matter of these claims in a continuation or divisional filing. Claims 20, 22, 25, and 26 have been amended and Claims 27-31 have been added. Entry of these amendments and reconsideration of the above-referenced application is respectfully requested. No new matter has been added herewith.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1, 3-7, 20-22, and 24-26 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claims 1 and 3-7 have been cancelled and Claim 20 has been amended to remove the recitation of the term “(e.g. human).” It is noted that Claim 20 recites a mammalian homologue that encompasses human homologues. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection under 35 U.S.C. §112, first paragraph

The Examiner rejected Claim 1 under 35 U.S.C. §112, first paragraph. These claims were rejected because the specification, while being enabling for polynucleotides that encode SEQ ID NO: 2, allegedly does not reasonably provide enablement for “an antisense oligonucleotide capable of hybridizing with, and inhibiting the translation of, mRNA encoded by a gene encoding a polypeptide of SEQ ID NOs: 2.” Claim 1 has been cancelled. Thus, this rejection is now moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection under 35 U.S.C. §102(b)

The Examiner rejected Claims 1, 5, and 6 under 35 U.S.C. §102(b) as being anticipated by Bonaldo *et al.* because this reference allegedly discloses DNA that shares 178 contiguous nucleotides with SEQ ID NO: 1. “Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. ...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *See Scripps Clinic & Research Foundation v.*

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Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Claims 1, 5, and 6 have been cancelled. Accordingly, this rejection is now moot.

Newly added claims 27-31 are not anticipated by Bonaldo *et al.*, because Bonaldo *et al.* does not disclose SEQ ID NO: 1 in its entirety. Independent claim 27 recites an isolated nucleic acid molecule comprising a ploy- or oligonucleotide selected from the group consisting of a polynucleotide encoding at least 50 contiguous amino acids from amino acids 1 to 148 of SEQ ID NO: 2; a polynucleotide encoding a polypeptide having at least 75% sequence identity with amino acids 1 to 203 of SEQ ID NO: 2 or a polynucleotide of SEQ ID NO: 1.

Bonaldo *et al.* only discloses a 178 nucleotide fragment of SEQ ID NO: 1. Thus, Bonaldo *et al.* does not disclose a polynucleotide of SEQ ID NO: 1. Furthermore, the fragment disclosed in Bonaldo *et al.* does not encode at least 50 contiguous amino acids in the region of amino acids 1 to 148 of SEQ ID NO: 2. The polynucleotide sequence disclosed in Bonaldo *et al.* only encodes amino acids 116 to 176 of SEQ ID NO: 2. Similarly, the fragment disclosed in Bonaldo *et al.* does not encode a polypeptide having at least 75% sequence identity with amino acids 1 to 203 of SEQ ID NO: 2.

Because the sequence disclosed in Bonaldo *et al.* does not disclose all the elements of the claimed invention, the cited reference does not anticipate the pending claims. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection under 35 U.S.C. §103(a)

The Examiner also rejected Claims 4 and 7 under 35 U.S.C. 103(a) as allegedly being unpatentable over Bonaldo *et al.* in view of the prior art. To establish a *prima facie* case of obviousness, the PTO must, *inter alia*, cite a prior art reference that provides some suggestion or motivation, either in the reference itself or in the knowledge generally available among those of ordinary skill in the art, to modify the reference cite a prior art reference to achieve the claimed invention. Claims 4 and 7 have been cancelled, thus the rejection of these claims is now moot.

New Claims 27-31 are not obvious over Bonaldo *et al.* because the polynucleotide sequence disclosed in Bonaldo *et al.* is only a fragment of SEQ ID NO: 1. One of ordinary skill in the art would not have been motivated to construct the sequence of SEQ ID NO: 1 based on the disclosure of Bonaldo *et al.* Moreover, Bonaldo *et al.* does not encode at least 50 contiguous amino acids from amino acids 1 to 148 of SEQ ID NO: 2 or a polypeptide having at least 75%

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sequence identity with amino acids 1 to 203 of SEQ ID NO: 2. Because one of ordinary skill in the art would not be motivated to modify the teachings of Bonaldo *et al.* to achieve the claimed invention, there can be no finding of obviousness. For the above stated reasons, Applicants respectfully request withdrawal of this rejection.

New Claims

Applicants have added new Claims 27-31, support for which can be found throughout the specification. Applicants wish to point out that independent Claim 27 is directed to the elected nucleic acid species, SEQ ID NO: 1 which encodes the polypeptide having the amino acid sequence: SEQ ID NO: 2. The Examiner has indicated that the specification is "enabling for polynucleotides that encode SEQ ID NO: 2." (See Page 3 of the Office Action). Furthermore, Applicants have strived to avoid using language that the Examiner has alleged to be vague and indefinite.

For all of the above reasons, Applicants respectfully request withdrawal of all rejections and allowance of the pending application.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

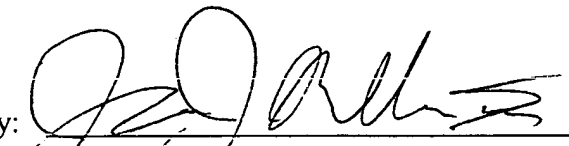
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 16 July 2003

By: 
James J. Mullen III, Ph.D.
Registration No. 44,957
Attorney of Record
Customer No. 20,995
(619) 235-8550

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